

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-27 are presently active. Claims 3-5, 9, 13, 17-21, 23, and 27 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, the Examiner requested information under 37 C.F.R. § 1.105; the Information Disclosure Statement was objected to as containing a “tremendous volume of references;” Claims 12-20 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter; Claims 1-27 were rejected under 35 U.S.C. § 112, first paragraph; Claims 1-27 were rejected under 35 U.S.C. § 112, second paragraph; Claims 1-27 were rejected under 35 U.S.C. § 102 as being anticipated by thirty-one U.S. patents; Claims 1-27 were rejected under 35 U.S.C. § 102(b) as being in public use or on sale more than one year prior to the filing of the present application; Claims 1-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the “examiner’s personal experience” involving the Performance Bicycle Company sales catalog; Claims 1-27 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,041,309 (hereinafter “the ‘309 patent”) and the claims recited in U.S. Patent No. 6,076,069 (hereinafter “the ‘069 patent”); and Claims 1-27 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims in co-pending U.S. applications 09/573,279; 09/573,706; 09/5873,727; and 09/596,664 (hereinafter the ‘279, ‘706, ‘727, and ‘664 applications, respectively).

Applicants respectfully traverse the requirement for the submission of additional information “reasonably necessary” to properly examine and treat the claimed subject matter, pursuant to 37 C.F.R. § 1.105. Under Rule 105, “the information required would typically be that necessary for finding prior art or for resolving an issue arising from the results of the search for art or from analysis of the application file.” M.P.E.P. § 704.11. Moreover,

the criteria of reasonable necessity is generally met, e.g., where (A) the Examiner’s search and preliminary analysis demonstrates that *the claimed subject matter cannot be adequately searched by class or keyword* among patents and typical sources of non-patent literature, or (B) the application file or the *lack of relevant prior art found in the Examiner’s search* justifies asking the Applicant if he or she has information that would be relevant to the patentability determination.²

However, in the instant case, Applicants note that an abundance of prior art references are available to the Examiner. For example, as noted in the Office Action, Applicants have submitted more than 170 prior art references. Moreover, the Office Action has asserted that Claims 1-27 are anticipated by each of *thirty-one* references, and has asserted six references in a double-patenting rejection of the claims. Thus, Applicants fail to understand the necessity of a Rule 105 requirement in the present application since there appears to be no shortage of prior art references. Accordingly, Applicants respectfully traverse the requirement of the submission of additional information under 37 C.F.R. § 1.105.

² MPEP § 704.11. Emphasis added.

Regarding the objection to the Information Disclosure Statement, Applicants are unaware that any one particular reference or group of references is more significant to the patentability of the claims in the present application than any other submitted reference. Moreover, Applicants note that all of the submitted references have been acknowledged and considered by the Examiner. Further, Applicants note that the significance of at least thirty-one of the submitted references is already known to the Examiner, since those references have been applied in a rejection of the claims under 35 U.S.C. § 102. Accordingly, Applicants respectfully traverse the request to explain the significance of each submitted reference.

Applicants respectfully traverse the rejection of Claims 12-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Initially, Applicants note that Claim 12 requires a connection between a commercial server system and a promotional server system over a network. Thus, contrary to the assertion in the Office Action that the establishing and transferring data steps can be performed by “thinking and speaking,”³ Applicants submit that independent Claim 12 is directed to a process that requires interaction with physical structures (e.g., servers and a network) and produces a useful, concrete, and tangible result (e.g., a display of computed statistical results). Moreover, Applicants reject the assertion in the Office Action that “each of the claim steps can be completely performed by a human” since Claim 12 requires that promotion data must be transmitted between two servers over a network. Accordingly, Applicants respectfully traverse the rejection of Claims 12-20 under 35 U.S.C. § 101.

Applicants respectfully traverse the rejection of Claims 1-27 under 35 U.S.C. § 112,

³ Page 5 of the outstanding Office Action.

first paragraph, as not being described in such a way as to enable one of ordinary skill in the art to make and/or use the invention. Initially, Applicants note that the Office Action asserts that the steps in the independent claims are “considered non-enabling because the specification does not provide a concrete example or illustrat[ion] of those claimed steps.”⁴ However, Applicants note that Figures 3-11 and pages 10-13 of the specification provide a detailed example of the operation of the claimed invention. In particular, examples related to the terms and statistics of one or more item promotions are described with regard to Figures 3-7. Accordingly, Applicants respectfully submit that one skilled in the computer programming art would be able to make and use the claimed invention by reading the specification and referring to the associated drawings. Accordingly, Applicants respectfully traverse the rejection of Claims 1-27 under 35 U.S.C. § 112, first paragraph.

Regarding the rejection of the claims under 35 U.S.C. § 112, second paragraph, Claims 3-5, 9, 13, 17-21, 23, and 27 have been amended to address the questions of antecedent basis noted in the Office Action. Accordingly, Applicants respectfully submit that the rejections of Claims 1-27 under 35 U.S.C. § 112, second paragraph, are rendered moot by the present amendment to those claims.⁵

Applicants respectfully traverse the rejection of Claims 1-27 under 35 U.S.C. § 102 as anticipated by the thirty-one references disclosed on page 9 of the outstanding Office Action. Initially, Applicants note that Rule 104 requires that:

in rejecting claims for want of novelty or for obviousness, the Examiner must cite the best references at his or her command.

⁴ See page 6 of the Office Action of February 12, 2003.

⁵ Moreover, Applicants fail to understand the broader statements of indefiniteness noted in the outstanding Office Action on pages 7 and 8. For example, Applicants fail to understand the statement that some of the claim steps are considered indefinite “because the specification does not provide an antecedent basis of those claimed steps.” Moreover, Applicants fail to understand the relevance of the statement that “the specification discusses those claimed concepts but does not particularly point out and distinctly claim the subject matter which Applicant regards as the invention.” Applicants fail to see the relevance of the *specification* in a rejection under 35 U.S.C. § 112, second paragraph.

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. *The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.*⁶

The Office Action has failed to identify with specificity those sections within the thirty-one cited references that read on the elements recited in Claims 1-27. Moreover, Applicants respectfully submit that the applied references fails to anticipate the claimed invention.

For example, U.S. Patent No. 4,882,675 to Nichtberger et al. (hereinafter “the ‘675 patent”) is directed to a paperless system for distributing, redeeming, and clearing merchandise coupons. However, the ‘675 patent fails to disclose a system and method for managing promotions including a promotion server system configured to transfer data representative of the *terms and statistics of promotions* to a commercial server over a network. Rather, the ‘675 patent is merely directed to using an electronic card to verify that items purchased by a customer are eligible for particular coupons selected by the customer electronically.

In addition, U.S. Patent No. 5,173,851 to Off et al. (hereinafter “the ‘851 patent”) is directed to a method and apparatus for dispensing discount coupons in response to the purchase of one or more products. However, the ‘851 patent fails to disclose a system and method for managing promotions of a network including transferring *terms and statistics* of various promotions or the performance of the promotions from a promotion server to a commercial server over a network, as recited in independent Claims 1, 12, and 21. Rather,

⁶ 37 C.F.R. § 1.104(c)(2). Emphasis added.

the '851 patent is merely directed to the automatic printing of a coupon in response to a purchase of a particular product at the point of sale in a store.

Further, U.S. Patent No. 5,128,752 to Von Kohorn (hereinafter "the '752 patent") is directed to a system and method for generating and redeeming tokens generated in a television viewer's home by the viewer entering selected product information and by authentication data transmitted to and displayed on the television. The tokens and coupons of the '752 patent can be presented to stores or redemption facilities for prizes and discounts on selected products. However, Applicants respectfully submit that the '752 patent fails to disclose a system and method for managing promotions over a network, comprising a promotion service system and a commercial service system in which data representative of the terms and statistics of promotions are transmitted from the promotion server to the commercial server over a network, as recited in the independent Claims 1, 12, and 21.

Further, with respect to the other cited references, those other references do not appear any more relevant than the above-noted '675, '851, and '752 patents, which all have deficiencies as noted above.

Accordingly, Applicants respectfully traverse the rejection of Claims 1-27 as anticipated by the applied references. Moreover, Applicants respectfully request that, pursuant to 37 C.F.R. § 104, the pertinence of each applied reference be more specifically described in any future rejection of the claims in the present application.

Applicants respectfully traverse the rejection of Claims 1-27 as being in public use or on sale under 35 U.S.C. § 102(b). Applicants note that, contrary to the statement in the Office Action that "[i]t is considered public use to assign the claimed elements to another

more than one year prior to filing,”⁷ assignment of rights to an invention does not place the invention in public use or on sale. See Moleculon v. CBS, 793 F.2d 1261 (Fed. Cir. 1986).

Applicants respectfully traverse the stated requirement in the Office Action for additional information regarding “when each of the claimed elements was placed in public use or offered for sale more than one year prior to the filing of the present application.”⁸ Initially, Applicants note that the Office Action has failed to indicate authority for such a request, and that the burden of showing that the claimed invention was not on sale or in public use is not on Applicants. Moreover, Applicants object to the requirement’s *implication* that the claimed invention was, in fact, in public use or offered for sale more than one year prior to the filing of the present application. Applicants respectfully submit that absent any evidence of record, simply stating that “an issue of public use or on sale activity has been raised in this application” is not grounds for shifting the burden and requiring an Applicant to provide additional information. Applicants have also provided all material that Applicants’ are aware of that is deemed material to patentability in the cited Information Disclosure Statement.

Applicants respectfully traverse the rejection of Claims 1-27 as obvious over “examiner’s personal experience.” Initially, Applicants request the submission of an *affidavit* by the Examiner detailing the specific teachings of the Examiner’s experience, as required under 37 C.F.R. § 1.104(d)(2) and M.P.E.P. § 2144.03. Moreover, Applicants fail to see the relevance to the present invention of the Examiner’s personal experience in redeeming a coupon over the telephone.

⁷ Page 10 of the Office Action of February 12, 2003.

⁸ *Id.*

Moreover, the stated motivation for modifying the Examiner's personal experience is to "allow advertisers greater consumer targeting capabilities through electronic mediums, while transferring electronic information."⁹ However, Applicants respectfully submit that the Office Action is simply stating perceived advantages of Applicants' invention, without establishing that one of ordinary skill in the art would even have thought to address the problem. Such hindsight reconstruction of Applicants' invention cannot be used to establish a *prima facie* case of obviousness. Effectively, the Office Action is asserting that one of ordinary skill in the art would have been motivated by the contents of the Performance Bicycle Catalog to design a system for managing promotions over a network that includes a promotion server system and a commercial server system, wherein terms and statistics of the promotions, including the number of promotions redeemed, the value of the redeemed coupon promotions, and the ability to start and end promotions may be tracked. However, Applicants respectfully submit that the Office Action has failed to provide any adequate motivation for one of ordinary skill in the art to make such a modification. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claims 1-27 should be withdrawn.

Applicants respectfully traverse the rejection of Claims 1-27 as being unpatentable under the judicially created doctrine of obviousness-type double patenting over the '309 and '069 patents. Applicants submit that neither the '309 or '069 patents is directed to a system for managing promotions over a network in which data representative of the *terms and statistics* of various promotions are transferred between a promotion server and a commercial server, as recited in independent Claims 1, 12, and 21. Moreover, Applicants note that the

⁹ In this regard, Applicants fail to understand the statement that "the motivation to *combine Applicants' claimed invention* with the services offered by Performance..." since Applicants' claimed invention is not being used as a prior art reference.

Office Action has failed to indicate specifically how the claims in the '069 and '309 patents read on the claims in the present invention. Further, whether the term "electronic coupon" is an obvious variation over the claimed "promotion" is not dispositive of whether Claims 1-27 are obvious over the claims recited in the '309 and '069 patents.

Similarly, Applicants respectfully traverse the rejection of Claims 1-27 as provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims in the co-pending '279, '706, 727, and '664 applications. Applicants submit that those applications fail to recite a system for managing promotions in which data representative of the terms and statistics of the promotions are recorded and transferred between a commercial server and a promotion server. Moreover, Applicants respectfully submit that the Office Action has failed to specifically describe how the claims in the cited co-pending applications read on Claims 1-27.¹⁰

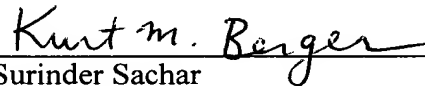
Thus, it is respectfully submitted that independent Claims 1, 12, and 21 (and all associated dependent claims) patentably define over the cited references.

¹⁰ Moreover, Applicants note that a "e-tail server" is not an obvious variation of a "promotion" or a "electronic coupon."

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully Submitted,

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